

SIEMENS

PATENT

Attorney Docket No. 2001P07053WOUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventor:	Thomas Völkel)	Group Art Unit: 2857
Serial No.:	10/764,295)	Examiner: Jeffrey R. West
Filed:	January 23, 2004)	Confirmation No." 8259
Title:	SPECTRAL EVALUATION OF AN OBJECT TO BE TESTED		

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APPELLANT'S REPLY BRIEF UNDER 37 CFR 41.41

This reply brief is in response to the Examiner's Answer mailed on December 31, 2007.

Appellant respectfully submits that the Examiner misconstrues the teachings of Hoth. More particularly, Hoth uses various parameters, (including temperature) as represented in blocks 310, 320 and 333 in FIG. 9, as respective multipliers for adjusting a calculated probability of failure, as represented in block 340. For the convenience of the Board, appellant has attached a copy of FIG. 9 of Hoth to this reply.

One skilled in the art would appreciate that the concept of adjusting a probability of failure (Hoth) has nothing to do with the use of parameters as a basis for changing the amplitude values of an alarm curve, as set forth in each of the rejected claims.

Further, combining the system described by Hoth (related to adjustment of a probability) with Lofall or Piety (related to adjustment of alarm curves) would require a complete restructuring of the system described by Hoth and the destruction of its functionality, which is not within the purview of obviousness.

Appellant further believes that this is a case of impermissible hindsight reconstruction, in which the Examiner's finding of a motivation to substitute the adjustment of a probability used by Hoth for the alarm curve adjustment of Lofall or Piety rests on generalized statements of advantages without regard to the desirability or the feasibility of modifying Hoth. Given the subtle but powerful attraction of a hindsight-based obviousness analysis, the CAFC has required a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, for example, *In re Dembicza*k, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) (quotations omitted).

Appellant further submits that the generalized statement by the Examiner (that temperature is a desired parameter for analysis of rotating machinery) does not meet the teaching or motivation required to combine the prior art references to sustain the §103 rejection of the claimed invention. Consequently, the rejection of claims should be overturned.

Respectfully submitted,

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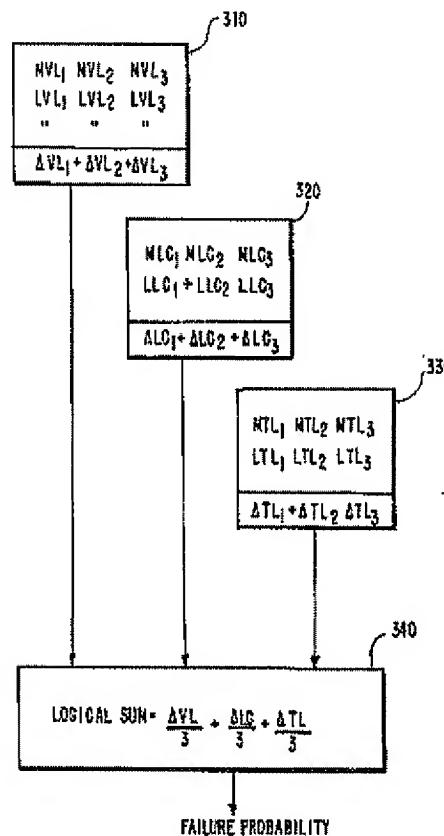


FIG. 9